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EXAMINER

MCLEAN, NEIL R

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/630,863
Filing Date: July 31, 2003
Appellant(s): HOUSE ET AL.

Daniel A. Tanner III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/20/2008 appealing from the Office action mailed 6/18/2008.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,988,431

Roe

11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-6, 8-10, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. (US 2002/0105665) hereinafter 'Wasilewski', in view of Roe (US 5,988,431).

Regarding Claim 5:

Wasilewski discloses a method (e.g., Methods for using an individually integrated kiosk that combines the photographic imaging products/services functionality of an imaging kiosk, with the non-imaging products/services functionality of a non-imaging type kiosk. [0015]) of purchasing a portable digital storage media from a digital image forming device (e.g., Kiosk 10 in Figure 1; [0056]; lines 5-9), comprising:

purchase determining (Figure 5 discloses The customer is also prompted to **select the particular image product/service** 208. **Other outputs at the kiosk include CD, memory card/stick and disk** using the

computer 112 peripherals as described in [0060], lines 27-31) whether to purchase media, the purchase determining comprising selecting a portable digital storage media type (The program code or device as described in [0056]; lines 17-20 which allows the user to make a selection);

media transfer determining whether to transfer image data between physical media (e.g., obtain an image from imaging camera 101, image scanner 106, or from a file stored on media such as a CD, memory card/stick, disk using the peripheral options available on the computer 112 as described in [0060]),

the media transfer determining comprising transferring the image data from external media to internal media through a memory ("so as to begin the image acquisition process 204" as described in [0060]);

network transfer determining whether to transfer the image data from a network (e.g., **obtain** an image from a **remote location via the network** connection 118 as described in [0060]);

the network transfer determining comprising determining a remote target and downloading the image data from a network to the internal media through the memory (See Remote Location Image Source Step 202 in Figure 5, which imports the desired image in Step 204);

upload transfer determining whether to upload the image data to a network (e.g., A network connection 24 is provided in kiosk 10 that is used to support the transaction processing, as well as provide other appropriate network services and support as described in [0056]),

the upload transfer determining comprising determining a remote target and uploading the image data from external media to the network (e.g., uploading & downloading the digital file to/from an Internet-enabled remote storage location or to remotely print and distribute images as described in [0011]);

transferring a computer image file from a network storage (The program code or device which performs the function described in [0058]; lines 26-40);

dispensing the portable digital storage media (The program code or device which performs the function described in [0060]; lines 27-31); and

selecting a remote target (Step 202 in Figure 5) and transferring the computer image file from the network storage to the portable digital storage media (The program code or device which performs the function described in [0060]; lines 7-13), before the step of dispensing the portable digital storage media at the remote target (The program code or device which performs the function described in [0060]; lines 27-31).

Wasilewski does not disclose expressly wherein the purchase includes the purchase of a blank portable digital storage media at the kiosk.

Roe discloses wherein the purchase includes the purchase of blank portable digital storage media at the kiosk (e.g., One object of the present invention is to enhance the availability of computer memory through information storage disks made available by disk vending machines. Column 2, lines 42-53; Figure 7).

Roe & Wasilewski are combinable because they are from the same field of endeavor of image processing, e.g., providing imaging products at a kiosk. The main reference Wasilewski discloses a kiosk that is equipped to read digital images from various sources such as CD's, memory sticks, memory cards, and floppy disks or obtain data over a communication network. Wasilewski also discloses outputs at the kiosk which include CD, memory card/stick and disks as well as digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the sale of blank portable media storage devices as taught by Roe in the integrated kiosk of Wasilewski. The suggestion/motivation for doing so

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would be to provide the user with the option to purchase blank storage media from a kiosk instead of a retailer. "These disks are available from commercial retail operators, but the locations and office hours of these retailers is limited" as disclosed by Roe in Column 1, lines 38-40....and it "enhances the availability of computer memory through information storage disks made available by disk vending machines." Therefore, it would have been obvious to combine Roe's option to purchase the blank media storage device at the kiosk with Wasilewski's integrated kiosk to obtain the invention as specified in order to enhance the availability of portable computer storage made available through a vending machine.

Regarding Claim 8:

Claim 5 teaches the method. Claim 8 is obvious over Wasilewski in view of Roe because the system is achieved using the method steps of Claim 5.

Regarding Claim 6:

Wasilewski further discloses the method of claim 5, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW ([0060]; lines 27-31).

Regarding Claim 9:

Wasilewski further discloses the system of claim 8, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW ([0058]; lines 17-22); and

wherein the media distribution device is a digital image forming device, and the portable digital storage media is one or more of CD-ROM, DVD-ROM and CD-RW

([0060]; lines 27-31).

Regarding Claim 10:

Wasilewski further discloses the system of claim 8, wherein the digital image forming device is a digital photocopier (e.g., Printer 18 in Figure 1).

Regarding Claim 12:

Wasilewski discloses a system for transferring a computer file from a portable digital storage media (e.g., a customer kiosk for providing financial and imaging goods and/or services, the kiosk having a customer input device; a display device; a mechanism for receiving and/or providing monetary transfer by the customer; and a scanning device for scanning of documents provided to the kiosk; and a communication mechanism for communicating with a computer system at a remote location and providing information to the computer system obtained by the scanning mechanism; as described in [0027]; lines 1-10), the system comprising:

purchase determining unit determining (Figure 5 discloses The customer is also prompted to **select the particular image product/service 208. Other outputs at the kiosk include CD, memory card/stick and disk** using the computer 112 peripherals as described in [0060], lines 27-31) whether to purchase media, the purchase determining unit comprising selecting a portable digital storage media type (The program code or device as described in [0056]; lines 17-20 which allows the user to make a selection);

media transfer determining unit determining whether to transfer image data between physical media (e.g., obtain an image from imaging camera 101, image scanner 106, or from a file

stored on media such as a CD, memory card/stick, disk using the peripheral options available on the computer 112 as described in [0060]],

the media transfer determining unit comprising transferring the image data from external media to internal media through a memory, ("so as to begin the image acquisition process 204" as described in [0060]);

network transfer determining unit determining whether to transfer the image data from a network (e.g., **obtain** an image from a **remote location via the network** connection 118 as described in [0060]),

the network transfer determining unit comprising determining a remote target and downloading the image data from a network to the internal media through the memory (See Remote Location Image Source Step 202 in Figure 5, which imports the desired image in Step 204);

upload transfer determining unit determining whether to upload the image data to a network upload (e.g., A network connection 24 is provided in kiosk 10 that is used to support the transaction processing, as well as provide other appropriate network services and support as described in [0056]),

the upload transfer determining unit comprising determining a remote target and uploading the image data from external media to the network (e.g., uploading & downloading the digital file to/from an Internet-enabled remote storage location or to remotely print and distribute images as described in [0011]);

a media distribution device for distributing a storage media (Step 218 in Figure 5 describes the Kiosk **dispensing** media);

a portable digital storage media read/write interface for coupling the portable digital storage media to the media distribution device (The portion of the function described in [0060]; lines 7-13 which enables the read/write interface; e.g., Multi-Card reader 116 in Figure 3);

a target selector (e.g., Touch Display Screen User Interface 102 in Figure 3; [0058]; lines 6-12) for selecting a remote target and transferring a computer image file from a network storage to the portable digital storage media to be dispersed at the remote target (The program code or device which performs the function described in [0060]; lines 7-13); and

a payment interface (ATM Kiosk 40 in Figure 2) for accepting payment for a transaction (Figure 6; [0057]; lines 15-25) in which the computer file is transferred from the portable digital storage media to the storage media,

wherein the storage media is paper and the media distribution device is one or more of a digital photocopier, CD-ROM, DVD-ROM and CD-RW ([0060]; lines 27-31) and the media distribution device is a digital image forming device (See Computer 16 and 58 in Figure 4).

Wasilewski does not disclose expressly wherein the purchase includes the purchase of a blank portable digital storage media at the kiosk.

Roe discloses wherein the purchase includes the purchase of blank portable digital storage media at the kiosk (e.g., One object of the present invention is to enhance the availability of computer memory through information storage disks made available by disk vending machines. Column 2, lines 42-53; Figure 7).

Roe & Wasilewski are combinable because they are from the same field of endeavor of image processing, e.g., providing imaging products at a kiosk. The main reference Wasilewski discloses a kiosk that is equipped to read digital images from various sources such as CD's, memory sticks, memory cards, and floppy disks or obtain data over a communication network. Wasilewski also discloses outputs at the kiosk which include CD, memory card/stick and disks as well as digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the sale of blank portable media storage devices as taught by Roe in the integrated kiosk of Wasilewski. The suggestion/motivation for doing so would be to provide the user with the option to purchase blank storage media from a kiosk instead of a retailer. "These disks are available from commercial retail operators, but the locations and office hours of these retailers is limited" as disclosed by Roe in Column 1, lines 38-40....and it "enhances the availability of computer memory through information storage disks made available by disk vending machines." Therefore, it would have been obvious to combine Roe's option to purchase the blank media storage device at the kiosk with Wasilewski's integrated kiosk to obtain the invention as specified in order to enhance the availability of portable computer storage made available through a vending machine.

Regarding Claim 15:

Wasilewski further discloses the system of claim 12, further comprising:

a portable electronic device interface (e.g., Touch Display Screen User Interface 102; [0058]; lines 6-12), wherein the portable electronic device interface is in communication (See Communication Device 117 in Figure 3; [0058]; lines 26-31) with the portable digital storage media and wherein the portable digital storage media is controlled by a portable electronic device (e.g., Computer 112 in the Kiosk; [0058]; lines 22-26).

(10) Response to Argument

Regarding Applicant's Argument (page 12, lines 1-10):

“All the decisions (determinations) made in Wasilewski require a user, or customer, to make those decisions (determinations) as prompted on the touch screen user interface. It is unreasonable for the Office Action to allege that Wasilewski teaches at least purchase determining whether to purchase blank media, media transfer determining whether to transfer image data between physical media, network transfer determining whether to transfer the image data from a network, upload transfer determining whether to upload the image data to a network upload, transferring a computer image file from a network storage, dispensing the portable digital storage media, and selecting a remote target as recited in the pending claims. None of these steps recited in the pending claims require a user to make the required decision as prompted or at all.”

Examiner's Response:

The Examiner respectfully disagrees with the Applicant that none of the steps recited in the pending claims require a user to make the required decision as prompted or at all. It is clearly implied in Applicants disclosure and in the claims that in order for the system and method to work, some sort of input from a user is necessary. For example, the act of purchasing requires a user to select the goods or services, and in this particular case the user is responsible for initiating the process. The Examiner

points to Applicant's disclosure page 6, lines 1-2; "The user may purchase..."; page 6, lines 7-8, "the user pays for the user's purchases of products..." .

Regarding Applicant's Argument (page 16, lines 4-14):

"The combination of the applied references would impermissibly modify the principle operation of Wasilewski. Wasilewski provides the consumer with the flexibility to generate imaging products and conduct imaging services or perform ATM-related transactions independent of one another, to incorporate images into producing customized financial instruments at a kiosk, to access financial institution services to store or retrieve images as part of providing either imaging product/services or ATM financial instruments, and to utilize the customer's financial accounts and/or financial instruments as a means for payment of imaging products/services rendered at the kiosk. Clearly, modifying Wasilewski to enable a user to purchase blank portable digital storage media at the kiosk would impermissibly modify the principle operation of Wasilewski because one would not purchase blank media from an ATM."

Examiner's Response:

The Examiner respectfully disagrees with the applicant that the modification of Wasilewski would impermissible modify the principle operation of Wasilewski because one would not purchase blank media from an ATM.

Wasilewski's main invention relates to an integrated kiosk that provides imaging products and services. Wasilewski already provides for the purchase of media at the

kiosk, e.g., "For example obtain an image from a remote location via the network connection 118, imaging camera 101, image scanner 106, or from a file stored on media such as a CD, memory card/stick, disk using the peripheral options available on the computer 112" [0060]. Both of the Examiner's references disclose methods of collecting monies at the kiosk prior to providing services.

An aspect of the invention includes ATM like functionality ([0015]) in order to facilitate the transactions. That is to say Wasilewski provides for a networked connection to e.g., a financial institution as a means to process the customer's transactions.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Neil R. McLean/

Examiner, Art Unit 2625

Conferees:

/King Y. Poon/

Supervisory Patent Examiner, Art Unit 2625

Art Unit: 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625